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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,228	06/13/2006	Nicolas Drabczuk	09669/045001	9043
22511 7590 08/07/2008 OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010				
EXAMINER MARTINEZ, DAVID E				
ART UNIT 2181		PAPER NUMBER		
NOTIFICATION DATE 08/07/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/521,228

**Applicant(s)**

DRABCUK, NICOLAS

**Examiner**

DAVID E. MARTINEZ

**Art Unit**

2181

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 3/1/05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not include the inventor's signature.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 1, the term "the auxiliary device being arranged to effect a core functionality" (line 2) renders the claim indefinite since it is not clear if the auxiliary device effects a core functionality of itself or it effects a core functionality of the main device (the usb host). In addition, the term "one descriptor defines a functionality that is different from the core functionality" (lines 3-4) also renders the claim indefinite for the similar reasons as the first term above. It isn't clear which element is being referred to whose functionality is being defined differently.

Due to claims 2-6 being dependent from claim 1, they suffer from the same deficiencies and thus are rejected under the same rationale,

With regards to claim 7, it also includes similar terms as those found in claim 1 and thus it is rejected under the same rationale.

Due to claims 8-9 being dependent from claim 7, they suffer from the same deficiencies and thus are rejected under the same rationale,

Due to the vagueness and a lack of clear definiteness in the claims, the claims have been treated on their merits as best understood by the examiner.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication No. US 2001/0027500 A1 to Matsunaga.

With regards to claim 1, Matsunaga teaches a system comprising a main device [fig 1 element 10] and an auxiliary device [fig 1 elements 11, 13, 14 and 20 make up a USB device] arranged to co-operate with each other [abstract], the auxiliary device being arranged to effect a core functionality [abstract, paragraphs 14, 19, 35], the auxiliary device comprising descriptors, characterised in that at least one descriptor defines a functionality that is different from the core functionality [fig 1 and group element 20 including elements 21-30, fig 2 elements 41 and 42 - paragraphs 31, 32, 34].

With regards to claim 2, Matsunaga teaches the system according to claim 1, wherein the main device is a USB host [fig 1 element 10] and the auxiliary device is a USB device [fig 1 elements 11, 13, 14 and 20 make up a USB device, see abstract].

With regards to claim 3, Matsunaga teaches the system according to claim 2, wherein the functionality that is different from the core functionality is a mass storage functionality [fig 1 element 21 – paragraph 32].

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With regards to claim 4, Matsunage teaches the system according to claim 1, wherein the auxiliary device, when it is coupled to the main device, initially presents the descriptor, that defines a functionality that is different from the core functionality [abstract, paragraphs 14, 19, 35].

With regards to claim 5, Matsunage teaches the system according to claim 2, wherein the USB device comprises a driver for the USB host to be installed by simulating that the USB device is a mass storage [paragraphs 31, 32, 34, 35].

With regards to claim 7, Matsunage teaches an auxiliary device [fig 1 elements 11, 13, 14 and 20 make up a USB device] arranged to effect a core functionality, the auxiliary device comprising descriptors, characterised in that at least one descriptor defines a functionality that is different from the core functionality [fig 1 and group element 20 including elements 21-30, fig 2 elements 41 and 42 - paragraphs 31, 32, 34].

With regards to claim 8, Matsunage teaches the auxiliary device according to claim 7, wherein the auxiliary device is a USB device [fig 1 elements 11, 13, 14 and 20 make up a USB device, see abstract].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. US 2001/0027500 A1 to Matsunaga in view of US Patent No. 6,151,647 to Sarat.

With regards to claims 6 and 9, Matsunaga is silent as to wherein the USB device (auxiliary device - claim 9) is a smartcard. However, Sarat teaches the use of a USB device as a smartcard device for the benefit of supporting compatibility with multiple different protocols [Sarat abstract, column 2 lines 32-60].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Matsunaga and Sarat to have the USB device (or auxiliary device) be a smartcard for the benefit of supporting compatibility with multiple different protocols [Sarat abstract, column 2 lines 32-60].

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,754,725 to Wright et al. teaches a USB device element 100 and a USB host element 102. The usb device provides storage capabilities, descriptors and device drivers to the USB host element.

US Patent No. 6,216,230 to Rallis et al. teaches a USB smartcard device that communicates with a USB host.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. MARTINEZ whose telephone number is (571)272-4152. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alford Kindred can be reached on 571-272-4037. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DEM

/Alford W. Kindred/  
Supervisory Patent Examiner, Art Unit 2181